

## REMARKS

### **Amendment to the Specification**

The Specification has been objected to for failure to have a description of Figure 7A.

Applicant has amended the Specification to provide such a description. Therefore, the objection is moot.

Claim 34 has been objected to due to an ambiguity with respect to its dependency. Claim 34 has been cancelled such that this objection is moot.

Claims 1-3 have been rejected under 35 U.S.C. § 103 as being obvious over the combination of Marin and Fann. Claims 6, 7, 9, 10 and 12-15 have been rejected under 35 U.S.C. § 103 based upon the combination of Marin, Fann and Kondratuk. Claims 1-5, 7, 30 and 38-40 have been rejected under 35 U.S.C. § 103 based upon Chen, Marin and Fann. Claims 6, 9, 10, 12-15, 31, 32, and 34-37 have been rejected under 35 U.S.C. § 103 based upon Chen, Marin, Fann and Kondratuk. Applicant respectfully traverses these rejections, and requests reconsideration of the claims, as amended.

Claim 1 has been amended to incorporate the limitations from cancelled claim 6, and thus requires a dead bolt having a stop to limit rotation of the cam. Claim 1 has further been amended to provide that the cam pivots about an axis spaced from the dead bolt. These limitations are not met by the cited references.

The Kondratuk patent is cited as having edges 32, 34 which define stops to limit rotation of the cams, in accordance with the requirement of claim 1, from cancelled claim 6, regarding the stop. However, in Kondratuk, the pivot axis of the cam resides within the dead bolt, rather than being spaced from the dead bolt in accordance with claim 1. Therefore, it is not obvious to

modify Marin so as to utilize the cam of Kondratuk, as suggested by the Examiner, since the resulting modified cam will not meet the limitations of amended claim 1.

Furthermore, the Examiner's alleged motivation for combining Marin and Kondratuk lacks any basis or evidence, and therefore is improper. The Examiner asserts that the motivation for combining Marin and Kondratuk is "to ensure the prevention of a lockout situation between the cam and dead bolt of Marin." See Office Action, page 4, lines 5-6. However, in Marin, separate pins 82 are provided on the walls 24 of the lock to limit rotation of the cam 74, and thereby prevent a lockout situation. See Figure 4, and column 3, lines 36-40. Thus, since Marin already has stops to prevent a lockout situation, there is no motivation to substitute the Kondratuk cam for the Marin cam, merely to get the same result. Since there is no motivation to combine the references, the § 103 rejection must be withdrawn.

The Federal Circuit has stated that for a § 103 obviousness rejection based upon a combination of patents, there must be "some objective teaching" leading to the combination. In re Fritch, 972 F.2d 1260, 1265 (Fed. Cir. 1992). As further explained by the Federal Circuit at In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999), this showing must be "clear and particular." Also, as further stated by the Federal Circuit, "an Examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would compel one skilled in the art do what the patent applicant has done." Ex parte Levengood, 28 U.S.P.Q.2d 1300, 1302 (Fed. Cir. 1993).

As the Board of Patent Appeals and Interferences has stated, "citing references which merely indicate that isolated elements and/or features recited in claims are known is not sufficient basis for concluding that the combination of claimed elements would have been obvious." Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (B.P.A.I. 1988).

Here, the Examiner has provided no evidence to support the asserted motivation for combining Marin and Kondratuk. The motivation is merely an unsupported conclusion without support in the references. Since claim 1 sets forth unique structure, operation and results which is not taught or suggested by the references, and since there is no motivation for combining the references, the § 103 rejection of claim 1 based upon Marin, Fann and Kondratuk must be withdrawn. Claims 2-5, 7, 9, 10 and 12-15 depend from claim 1 and should be allowable as depending from an allowable base claim.

Independent claim 30 is similar to claim 1 in requiring that the cam have a pivot axis spaced from the dead bolt. Claim 30 also provides that the dead bolt have a notch with a lip to prevent the finger of the cam from pivoting out of the notch into a lockout situation, similar to claim 1.

The Examiner suggests that it would be obvious to modify Chen to include the cam arm, cam finger, and first and second notches of Kondratuk, with the motivation being to prevent a lockout situation and to enable the stops 96 of Chen to not be required. See Office Action page 5, lines 8-12. However, the Examiner acknowledges that Chen already has stops 96. These stops prevent over-rotation of the Chen cam 42, 88 so as to prevent a lockout situation. There is no evidence to support the Examiner's stated motivation for combining Chen and Kondratuk. There mere substitution of the Kondratuk stop for the Chen stop to get the same result is not a sufficient basis for combining the references. The asserted motivation for combining Chen and Kondratuk is illusory and unsupported by any evidence in the references. Therefore, the combination of Chen and Kondratuk is improper such that the § 103 rejection must be withdrawn. Furthermore, to combine Chen and Kondratuk would contravene the requirement of claim 30 that the pivot axis of the cam be spaced from the dead bolt, as compared to the Kondratuk cam wherein the

pivot axis is within the dead bolt. Therefore, even if Chen and Kondratuk are combined, this limitation of claim 30 is not satisfied.

Accordingly, claim 30 is in proper form for allowance, along with dependent claims 32 and 36-40.

In view of the foregoing, Applicant respectfully requests that a Notice of Allowance be issued.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,

  
KIRK M. HARTUNG, Reg. No. 31,021  
McKEE, VOORHEES & SEASE, P.L.C.  
801 Grand Avenue, Suite 3200  
Des Moines, Iowa 50309-2721  
Phone No: (515) 288-3667  
Fax No: (515) 288-1338  
**CUSTOMER NO: 22885**

Attorneys of Record

- pw/bja -